

## **REMARKS**

This paper is responsive to a Final Office Action mailed August 18, 2008. Prior to this response, claims 1, 3-20, and 22-42 were pending. After amending claim 20, claims 1, 3-20, and 22-42 remain pending.

In Section 2 of the Office Action objections are made to claim 20. In response, claim 20 has been amended to recite “without”.

In Section 4 of the Office Action, claims 1, 3-20, and 22-42 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward et al. (US 7, 031,004), in view of Wadley (US 2002/0181014) and DeHority (US 5,129,639). The Office Action acknowledges that Hayward does not disclose determining imaging job characteristics, but that Wadley discloses these features, and that it would have been obvious to combine references to monitor the content of documents being printed for the easy relocation of print jobs. The Office Action acknowledge that Hayward and Wadley fail to disclose matching imaging system capabilities to job characteristics, but that DeHority discloses this feature, and it would have been obvious to include the features of Hayward/Wadley with DeHority's process as a way to provide the best match between printer capabilities and job requirements. This rejection is traversed as follows.

Hayward discloses a web-based printing service. The user is able to select print options, such as the number of copies and print destinations (col. 5, ln. 7-46). Hayward describes submitting the job to a

service bureau server (col. 5, ln. 65 through col. 6, ln. 7). The Office Action states that Hayward determines the imaging job file type without analyzing the imaging job content, since the type is previously known, citing col. 6, ln. 8-16. However, if the file type is known without analysis, then Hayward fails to disclose the limitation of “determining an imaging job file type”, as recited in claims 1 and 20.

Wadley discloses a system where monitoring software installed on a printer is used to determine whether the data streams associated with documents are of interest to the organization [0009]. The Office Action states that Wadley teaches an imaging device that, in response to a determined imaging job file type, determines imaging job characteristics, where the characteristics are determined in accordance with print data within a print job, citing [0027].

Thus, the Office Action acknowledges that Wadley determines imaging job characteristics in accordance with the print data in the job. In contrast, the claimed invention explicitly states that the imaging job characteristics are determined based upon the job file type.

In [0034] Wadley states that the context-analyzer is configured to analyze the data stream. “The analysis that is performed on the data stream by the context-analyzer pertains to, as the name implies, the context of the data stream itself. That is, each data stream that is printed necessarily has some context associated with it.” Wadley’s examples of context include an employment report, financial report, personnel evaluation, and resume.

Wadley discloses two means of analyzing context in the explanation of Fig. 6. They are: a structure detector and a keyword

detector. The structure detector ascertains structures or fields in a document, while the keyword detector searches for words or phrases [0038-0040]. In [0041], Wadley states that by identifying documents that meet certain definable profile characteristics, the context-analyzer can make intelligent decisions as to the nature or type of documents that are being printed.

DeHority discloses a process that uses paper supplied from a multi-paper supply system, where each supply corresponds to paper size, weight, color, and type. DeHority's process also uses stapling, folding, stacking, and duplexing options (col. 2, ln. 44-64). Each document to be processed includes a header where the paper, folding, stacking, stapling, and duplexing instructions are embedded. The process employs a best match strategy if the printer is unable to exactly comply with the header instructions (col. 3, ln. 5-50). In col. 12, ln. 30-43, DeHority states that the invention matches the capabilities of the printer with job requirements. However, DeHority does not analyze the print job to determine file type. DeHority does not determine the print job characteristics in response to determining file type. Rather, in DeHority's system the print characteristics are supplied in the header of the print job.

An invention is unpatentable if the differences between it and the prior art would have been obvious at the time of the invention. As stated in MPEP § 2143, the *KSR International Co. v Teleflex Inc.* decision (82 USPQ2d 1385, 1395-1397, 2007) suggests 7 exemplary rationales to support a conclusion of obviousness, which include:

A) Combining prior art elements according to known methods to yield predictable results;

B) Simple substitution of one known element for another to obtain predictable results;

C) Use of known technique to improve similar devices (methods, or products) in the same way;

D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

G) Some teaching, suggestion, or motivation in prior art would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

The Office Action states that modifications to Hayward would have been obvious to one of ordinary skill in the art in light of Wadley and DeHority. This rejection appears to be most closely grounded in the G) rationale - Some teaching, suggestion, or motivation in prior art

would have lead one of ordinary skill to modify the prior art reference or the combine prior art references teachings to arrive at the claimed invention.

With respect to this rationale, MPEP 2143 (G) states that the rejection must articulate the following criteria to resolve the *Graham* factual analysis:

(1) a finding that there was some teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings;

(2) a finding that there was a reasonable expectation of success; and

(3) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

With respect to the above-referenced first factual analysis criteria, none of the references disclose the limitation of determining the imaging job file type. More important, none of the references disclose determining imaging job characteristics as a result of initially determining the imaging job file type. As noted above, Wadley disclose determining imaging job characteristics as a result of analyzing job content. DeHority does not make any kind of determination regarding imaging job characteristics, since DeHority explicitly states that the invention uses a document specification or document header to define the job requirements, such as paper type, stapling, or collation (col. 3, ln. 5-50). Therefore, even if elements from Wadley and DeHority are combined

with Hayward, that combination does not explicitly disclose every limitation of claims 1 and 20. Claims 3-20, dependent from claim 1, and claims 22-42, dependent from claim 20, enjoy the same advantages.

The Office Action states that it would have been obvious to combine Wadley and Hayward to monitor the content of documents being printed for the easy relocation of print jobs. The Office Action states that it would have been obvious to combine Hayward/Wadley with DeHority as a way to provide the best match between printer capabilities and job requirements. However, the references clearly point away from the limitation of determining imaging job characteristics as a result of initially determining job file type. None of the references, including Hayward, disclose determining file type. Wadley clearly describes determining imaging job characteristics as a result of analyzing job content, while in DeHority, the job requirements are read from the job header. Thus, both DeHority and Wadley point to different methods of gathering imaging job characteristics.

Even if there exists some valid motivation to combine the three prior art references, it has not been proven that such a motivation suggests determining an imaging job's characteristics in response to determining the file type. A *prima facie* analysis of motivation is especially critical in the present circumstances since the rejection is predicated on limitations that are not explicitly disclosed in the prior art references. The claimed invention can only be obvious if an artisan makes substantial modifications to the Hayward reference. However, there is nothing in the Wadley or DeHority references that suggest such a modification.

Neither does the obviousness rejection provide evidence that such a modification would have been obvious to one with skill in the art based upon what was well known at the time of the invention. “(A)nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). However, if the *prima facie* rejection is supported by what was known by a person of ordinary skill in the art then additional evidence should have been provided. Notable, when the source or motivation is not from the prior art references, “the evidence” of motive will likely consist of an explanation or a well-known principle or problem-solving strategy to be applied”. *DyStar*, 464 F.3d at 1366, 80 USPQ2d at 1649. The Office Action does not supply evidence that it was well known at the time of the invention to determine imaging job characteristics after first determining the imaging job file type.

With respect to the second analysis criteria needed to support the G) obviousness rationale, even if an expert were given the Hayward, Wadley and DeHority references as a foundation, no evidence has been provided to show that there is a reasonable expectation of success in the claimed invention. That is, there can be no reasonable expectation of success if the references, and what was known by artisan at the time of the invention, do not teach all the limitations of the claimed invention.

In summary, the Applicant respectfully submits that a *prima facie* case of obvious has not been supported since the combination of Hayward, Wadley, and DeHority does not explicitly disclose every limitation of claims 1 and 20. Neither has a case been supported that DeHority can be modified to supply the missing limitations in view Wadley or of what was well known by a person of skill at the time of the invention. Therefore, the Applicant requests that the rejection of claims 1, 3-20, and 22-42 be removed.

In Section 5 of the Office Action, claims 7 and 30 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward, DeHority, and Wadley, and further in view of Wiechers (US 2002/0075509). The Office Action acknowledges that Hayward, DeHority, and Wadley fail to disclose image resolution capabilities, but that Wiechers discloses this feature, and that it would have been obvious to include the features of Wiechers with the processes of Hayward, DeHority, and Wadley to determine time and cost parameters. This rejection is traversed as follows.

Even if Wiechers' imaging resolution capabilities are combined with Hayward, Wadley, and DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the satisfying of time and cost parameters does not suggest modifications to Hayward, Wadley, and DeHority that would make these claim limitations obvious, based on either the Wiechers reference, or what was well known at the time. Since the combination of references neither



explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 7 and 30 be withdrawn.

In Section 6 of the Office Action, claims 8 and 25 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward, DeHority, and Wadley, and further in view of Neuhard (US 6,052,198). The Office Action acknowledges that DeHority and Wadley fail to disclose determining available print media information. The Office Action states that Neuhard discloses these features, and it would have been obvious to include the features of Neuhard with DeHority and Wadley to make a more efficient system. This rejection is traversed as follows.

Even if Neuhard's accessing of print media information is combined with Hayward, Wadley, and DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the improving of efficiency does not suggest modifications to Hayward that would make these claim limitations obvious, based on either the Wadley/DeHority/Neuhard references, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Hayward that would make all the limitations obvious, the Applicant requests that the rejection of claims 8 and 25 be withdrawn.

In Section 7 of the Office Action, claims 14-15 and 39-40 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward/Wadley/DeHority in view of Wiechers. The Office Action

acknowledges that Hayward/Wadley/DeHority fails to disclose matching system capabilities to job characteristics, but that Wiechers discloses this feature, and that it would have been obvious to include the features of Wiechers with Hayward/Wadley/DeHority to satisfy user time and cost parameters. This rejection is traversed as follows.

Even if Wiechers' system of matching network printer capabilities to job characteristics is combined with Hayward/Wadley/DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, the satisfying of time and cost parameters does not suggest modifications to Hayward/Wadley/DeHority that would make these claim limitations obvious, based on either the Wiechers reference, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Hayward/Wadley/DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 14-15 and 39-40 be withdrawn.

In Section 8 of the Office Action, claim 24 has been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward/Wadley/DeHority in view of Walker et al. ("Walker"; US 6,561,643). The Office Action acknowledges that Hayward/Wadley/DeHority fails to disclose a reader interface, but that Walker discloses this feature, and it would have been obvious to include the features of Walker with Hayward/Wadley/DeHority to automatically

adjust printing for optimal images based upon sensing the media entering the printer. This rejection is traversed as follows.

If Walker's reader interface is combined with Hayward/Wadley/DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, automatically making adjustments in response to the sensed media does not suggest modifications to Hayward/Wadley/DeHority that would make these claim limitations obvious, based on either the Walker reference, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claim 24 be withdrawn.

In Section 9 of the Office Action, claims 27 and 34 have been rejected under 35 U.S.C. 103(a) as unpatentable with respect to Hayward/Wadley/DeHority, in view of Ferlitsch (US 6,943,905). The Office Action acknowledges that Hayward/Wadley/DeHority fail to disclose a client with a print driver, but that Ferlitsch discloses this feature, and it would have been obvious to include the features of Ferlitsch with Hayward/Wadley/DeHority to access information concerning imaging device status. This rejection is traversed as follows.

If Ferlitsch's client driver is combined with Hayward/Wadley/DeHority, the combination still fails to explicitly describe a process that determines imaging job characteristics in response to first determining the imaging job file type. Further, accessing imaging device status does not suggest modifications to Hayward/Wadley/DeHority

that would make these claim limitations obvious, based on either the Ferlitsch reference, or what was well known at the time. Since the combination of references neither explicitly discloses all the claim limitations, nor suggests modification to Hayward/Wadley/DeHority that would make all the limitations obvious, the Applicant requests that the rejection of claims 27 and 34 be withdrawn.

It is believed that the application is in condition for allowance and reconsideration is earnestly solicited.

Respectfully submitted,

Date: 11/14/2008

/Mali/  
Gerald Maliszewski  
Registration No. 38,054

Customer Number 55,286  
P.O. Box 270829  
San Diego, CA 92198-2829  
Telephone: (858) 451-9950  
Facsimile: (858) 451-9869  
gerry@ipatentit.net